

REMARKS

The Official Action mailed December 17, 2008, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on March 15, 2004; February 9, 2005; August 30, 2005; February 22, 2006; and November 20, 2008.

Claims 1, 3, 4, 6-8, 10, 11, 13, 14, 16-18 and 20-32 are pending in the present application, of which claims 1, 4, 8, 11, 14 and 18 are independent. Claims 1, 4, 8, 11, 14 and 18 have been amended to better recite the features of the present invention. The Applicant notes with appreciation the indication of the allowability of dependent claims 7, 10, 17 and 20 (page 9, Paper No. 20081215). For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 4 of the Official Action rejects claims 1-32 under the doctrine of obviousness-type double patenting over claims 1-29 of U.S. Patent No. 6,707,484 to Kawasaki et al. In light of the prior cancellation of claims 2, 5, 9, 12, 15 and 19, it appears that paragraph 4 of the Official Action may have intended merely to reject claims 1, 3, 4, 6-8, 10, 11, 13, 14, 16-18 and 20-32. In any event, the Applicant traverses the rejection and respectfully submits that the independent claims of the subject application are patentably distinct from the claims of the Kawasaki patent.

As stated in MPEP § 804, under the heading "Obviousness-Type," in order to form an obviousness-type double patenting rejection, a claim in the present application must define an invention that is merely an obvious variation of an invention claimed in the prior art patent, and the claimed subject matter must not be patentably distinct from the subject matter claimed in a commonly owned patent. Also, the specification and

drawings of the patent principally underlying the double patenting rejection are not considered prior art.

The Applicant respectfully traverses the obviousness-type double patenting rejection. The independent claims of the present application recite a keyboard and a pointing device. The claims of the Kawasaki patent, on the other hand, do not recite these features. Therefore, it is respectfully submitted that the claims of the present application are patentably distinct from the claims of the Kawasaki patent.

It is respectfully submitted that the claims of the present application are not a timewise extension of the invention as claimed in the Kawasaki patent. Reconsideration and withdrawal of the obviousness-type double patenting rejections are requested.

Paragraph 7 of the Official Action rejects claims 1-32 under 35 U.S.C. § 112, second paragraph, asserting that claims 1, 4, 8, 11 and 18 are "indefinite in that it fails to point out what is included or excluded by the claim language," that "[t]his claim is an omnibus type claim," and that "[c]laim 1, 4, 8, 11 and 18 disclose the limitation 'are included in a [[same]] first housing,['] it is not clear if [[same]] included in the claim" (page 5, Paper No. 20081215; emphasis in original). In light of the prior cancellation of claims 2, 5, 9, 12, 15 and 19, it appears that paragraph 7 of the Official Action may have intended only to reject claims 1, 3, 4, 6-8, 10, 11, 13, 14, 16-18 and 20-32. In any event, the Applicant respectfully disagrees and traverses the above assertion in the Official Action.

The Official Action does not appear to be fully familiar with 37 CFR § 1.121 ("Manner of making amendments in application") and MPEP § 714 ("Amendments, Applicant's Action"), which note "that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters." As such, the term "same" was deleted in the previously filed *Amendment* by enclosing the word "same" in double brackets. As such, the basis for the confusion in the Official Action appears to have been the result of a misunderstanding of the rules for amending claims, not due to any substantive deficiency in the claims themselves.

Regarding the assertion that the present claims are "omnibus type" claims, the Applicant notes that MPEP §§ 706.03(d) and 2173.05(r) include examples of omnibus claims. The Applicant respectfully submits that the present claims are not "omnibus type" in any respect.

The Applicant respectfully submits that claims 1, 3, 4, 6-8, 10, 11, 13, 14, 16-18 and 20-32 particularly point out and distinctly claim the subject matter which applicant regards as the invention and are definite. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

Paragraph 10 of the Official Action rejects claims 1, 3, 4, 6, 8, 11, 13, 14, 16, 18 and 21-32 as obvious based on the combination of U.S. Patent No. 4,645,872 to Pressman, U.S. Patent No. 5,515,474 to Deacon, U.S. Patent No. 5,491,507 to Umezawa, and U.S. Patent No. 5,438,530 to Bettini. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 1, 4, 8, 11, 14 and 18 have been amended to recite that a keyboard and a pointing device are included in a second housing and are provided on a same surface of the second housing. For the reasons provided below, Pressman, Deacon, Umezawa and Bettini, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

The Official Action concedes that "Pressman in view of Deacon and further in view of Umezawa does not [disclose that] the keyboard and the pointing device are included in a second housing" but asserts that "Bettini discloses a portable computer, wherein the keyboard and the mouse [are] in the same housing (see Fig. 1)" (page 7, Paper No. 20081215). However, it is respectfully submitted that Bettini does not teach or suggest that a keyboard and a pointing device are provided on a same surface of a second housing or that Pressman, Deacon and Umezawa should be modified to include such features. Specifically, Bettini appears to teach that a keyboard 28 is provided on an upper part of base 22; however, a tracking device 24 is not provided on the upper part of base 22. Therefore, it is respectfully submitted that Bettini does not teach or suggest the above referenced features.

Furthermore, the Applicant respectfully submits that Pressman, Deacon and Umezawa do not cure the deficiency in Bettini. As noted above, the Official Action concedes that Pressman, Deacon and Umezawa do not disclose a keyboard and pointing device included in a second housing; hence, it follows that they do not disclose the keyboard and pointing device in the same surface of a second housing. Therefore, the Applicant respectfully submits that Pressman, Deacon, Umezawa and Bettini, either alone or in combination, do not teach or suggest that a keyboard and a pointing device are provided on a same surface of the second housing.

Since Pressman, Deacon, Umezawa and Bettini do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly,

reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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